

REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. Claims 1-20 were pending in this application at the time of the outstanding Office Action. Of these claims, Claims 1 and 20 are independent claims; the remaining claims are dependent claims. Claims 1-20 have been rejected. In response, Applicants submit this Amendment in which claims 1-20 have been cancelled and claims 21-40 are newly presented. The Office is respectfully requested to reconsider the rejections present in the outstanding Office Action in light of the foregoing amendments and the following remarks.

It should be noted that Applicants are not conceding in this application the claims cancelled herein are not patentable over the art cited by the Examiner, as the present claim cancellations and presentation of new claims are only for facilitating expeditious prosecution. Applicants respectfully reserve the right to pursue the cancelled claims and other claims in one or more continuations and/or divisional patent applications. Applicants specifically state no cancellation of any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the cancelled claim.

Rejections under 35 USC 101

Claims 1-20 stand rejected under 35 USC 101 as drawn to non-statutory subject matter. Claims 1-20 have been cancelled herein, rendering the Examiner's rejection moot.

Applicant respectfully submit the following regarding 35 U.S.C. § 101 statutory subject matter. As the Examiner is no doubt aware, currently “the machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101.” *In re Bilski*, 2007-1130, pp. 15, ___F.3d ___ (October 30, 2008). “The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms and article.” *Id* at pp.24 (citations omitted) (emphasis added).

Applicant respectfully submits that the claimed invention was previously directed to statutory subject matter, and that the instantly claimed invention is directed to statutory subject matter, as can be readily ascertained by reviewing the claim language.

Double Patenting Rejections

Claim 1 has been provisionally rejected on the ground of non-statutory double patenting over claim 1 of co-pending Application Serial No. 09/805,336 (hereinafter the ‘336 application). Claim 1 has been cancelled, rendering the double patenting rejection moot.

Without commenting on the merits of the now mooted objection, Applicants respectfully submit that the newly presented claims clearly do not warrant a double patenting rejection.

Rejections under 35 USC 103

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,918,014 to Robinson (hereinafter “Robinson”). Claims 1-20 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,031,932 to Lipsky (hereinafter “Lipsky”). Applicants respectfully disagree. Applicants note that claims 1-20 have been cancelled herein, rendering these rejections moot. However, Applicants respectfully submit the following regarding the Robinson and Lipsky references.

As an initial matter, Applicants’ previously submitted remarks of February 15, 2008, remain equally applicable here and therefore are incorporated by reference as if set forth fully herein. Moreover, Applicants respectfully submit that the Examiner impermissibly uses “Official Notice” throughout the Office Action (see pp. 20; pp. 24). Applicants respectfully traverse the asserted “Official Notice” and submit that this “Official Notice” glosses over a significant, novel feature of the instantly claimed invention — i.e., determining the effectiveness of various forms and formats of advertising on the Internet through controlled online experiments.¹ Although Applicants limit their remarks addressing these particular issues here, Applicants respectfully reserve the right to expand upon these issues should the need to do so arise. Applicants additionally present the following remarks.

¹ On Page 19 of the Office Action (first full paragraph), the Examiner appears to take Official Notice of the configuration data specifying a sample size. In the next two paragraphs, however, the Examiner appears to expand this notice to encompass “a sample size of visitors to the Internet website who are to participate in **an experiment**”. (Claim 1, emphasis added)

With regards to the propriety of the Examiner's taking of Official Notice, Applicants respectfully submit that the Examiner has the burden of providing "substantial evidence" to support the factual conclusion that claimed subject matter is notoriously well known in the art. MPEP § 2144.03. The Examiner should only take Official Notice unsupported by documentary evidence when the facts asserted to be well known "are capable of instant and unquestionable demonstration as being well known" so as to defy dispute. MPEP § 2144.03(A). It is **not appropriate** for the Examiner to take Official Notice asserting facts not capable of instant and unquestionable demonstration without citation of a prior art reference. Id. Citation to some prior art reference recognized as standard in the art is **always** necessary to support a specific assertion of specific knowledge in the prior art. Id. Assessments of common knowledge not based on any evidence in the record lack substantial evidence support. Id.

Further, the line of reasoning underlying the Examiner's decision to take Official Notice of a fact must be clear and unmistakable. MPEP § 2144.03(B). When Official Notice of common knowledge in the art is taken the Examiner must **explicitly** set forth the basis for such reasoning and "provide **specific** factual findings predicated on sound technical and scientific reasoning." Id.

The Examiner sets forth **no** documentary evidence or prior art references to support this assertion of **specific knowledge in the art**, as is required, in order to properly take Official Notice. MPEP § 2144.03(A). Nor does the Examiner relate, **at all**, how exactly the asserted notoriously well known claimed subject matter is capable of instant and unquestionable demonstration as being well known. Id. Moreover, the

Examiner **does not** provide any lines of reasoning or scientifically or technically based factual findings that support the conclusion that the claimed subject matter is notoriously well known in the art. MPEP § 2144.03(B).

For the foregoing reasons Applicants respectfully submit that the claimed subject matter subject to the Examiner's taking of Official Notice is not notoriously well known in the art and that the Examiner's taking of Official Notice is not supported by substantial evidence. MPEP § 2144.03(A), (C). The Examiner's taking of Official Notice with regards to the claimed subject matter is therefore improper.

Applicants respectfully submit that in order to maintain the current rejection the Examiner must provide concrete evidence to support the finding that the claimed subject matter is notoriously well known in the art. Or, if the Examiner's finding is based on personal knowledge, Applicants respectfully submit that the Examiner must provide an affidavit or declaration setting forth specific factual assertions and explanations that support the Examiner's finding pursuant to 37 C.F.R. § 1.104(d)(2). MPEP § 2144.03(C). Should the Examiner provide such concrete evidence, affidavit, or declaration, however, doing so precludes the Examiner from making the rejection of the claims final in the next Office Action as Applicants are entitled to have an opportunity to respond to the rejection on the merits.

The remarks will now turn to a significant, novel feature of the instantly claimed invention glossed over by the Examiner — i.e., determining the effectiveness of various forms and formats of advertising on the Internet through controlled online experiments. As best understood, Robinson teaches segmenting into groups (communities) to direct ads

based upon the groups and collecting data on a new add such that it can be associated with a group. *Robinson*, Abstract. This stands in stark contrast to the instantly claimed invention, wherein experimentation is conducted on a sample of visitors to the website to determine a currently optimal advertisement. Applicants respectfully submit that Robinson's teachings were incapable of rendering the prior claims obvious, and likewise further respectfully submit that Robinson's teachings are likewise incapable of rendering obvious, either alone or in any combination with the other art of record, the instantly claimed invention.

As best understood, Lipsky teaches ad campaigns run in various spots on various web sites. *Lipsky*, Fig. 1. Lipsky does not conduct experimentation on a sample of the visitors to a website to determine a currently optimal advertisement. Moreover, Lipsky focuses on cost packages (because ad space is being bought in connection with the ad campaigns, see Col. 2, line 62-Col. 3, line 6); whereas the instantly claimed invention does not require cost to be taken into consideration. Applicants respectfully submit that Lipsky's teachings were incapable of rendering the prior claims obvious and likewise are incapable of rendering obvious, either alone or in any combination with the other art of record, the instantly claimed invention.

Applicants briefly note that support for the newly presented claims can be found throughout the disclosure as filed, including the specification, claims and drawings. Support for the newly added claims is particularly evident at paragraphs [0023]-[0032]; [0043]-[0077]; [0079]-[0114]; and Figs. 2-4.

Applicants respectfully reiterate that the present claim cancellations and presentation of new claims is solely for the purpose of facilitating expeditious prosecution of this application.

Request for Telephone Interview

Applicants respectfully request that if after the Examiner has taken up and considered this Amendment, the Examiner determines there are outstanding issues remaining in this case precluding it from being in condition for allowance, that the Examiner contact the undersigned at the telephone number listed below. Applicants respectfully submit that this is a reasonable request in light of the extended prosecution history of this case.

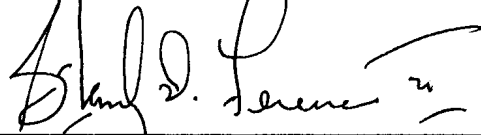
Conclusion

By virtue of dependence from what are believed to be allowable independent claims, it is respectfully submitted that Claims 22-29 and 31-40 are also presently allowable. Thus, it is respectfully submitted that the instant application, including Claims 21-40, is presently in condition for allowance. Notice to the effect is hereby earnestly solicited.

The “prior art made of record” has been reviewed. Applicants acknowledge that such prior art was not deemed by the Office to be sufficiently relevant as to have been applied against the claims of the instant application. To the extent that the Office may apply such prior art against the claims in the future, Applicants will be fully prepared to respond thereto.

Should the claims not be in condition for immediate allowance, the courtesy of a telephone interview is requested prior to the issuance of a further Office Action.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Stanley D. Ference III", written over a horizontal line.

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